

### **REMARKS**

These remarks respond to the Office Action mailed January 4, 2007. Claim 26 has been added. Claims 2-7, 9, 11-24, and 26 are pending in the application. Claims 9, 11, and 18 are independent claims. Applicants respectfully request reconsideration of all claims.

### **Information Disclosure Statement**

In the Office Action, the Examiner acknowledged receipt of the IDS submitted on September 9, 2006 but stated that it is “impractical to review the references thoroughly with the number of references cited in this case.” But Applicants note that “the filing of an information disclosure statement shall not be construed to be an admission that the information cited in the statement is, or is considered to be, material to patentability as defined in 37 CFR 1.56(b).” MPEP § 609.

Because the IDS was properly submitted and the appropriate fee paid, Applicants believe that the Examiner has a duty to consider the references under MPEP § 609.05(b), which states:

The information contained in information disclosure statements which comply with both the content requirements of 37 CFR 1.98 and the requirements, based on the time of filing the statement, of 37 CFR 1.97 will be considered by the examiner. Consideration by the examiner of the information submitted in an IDS means that the examiner will consider the documents in the same manner as other documents in Office search files are considered by the examiner while conducting a search of the prior art in a proper field of search...

Examiners must consider all citations submitted in conformance with the rules, and their initials when placed adjacent to the considered citations on the list or in the boxes provided on a form \*\* PTO/SB/08A and 08B provides a clear record of which citations have been considered by the Office.

Applicants do not believe they are under any duty to discuss specific references. Because Applicants followed the proper procedures and paid the proper fee to have the references

considered, Applicants respectfully request that the Examiner consider the references listed in the IDS.

To assist the Examiner in this task, Applicants direct the Examiner to the following references which may be of particular interest: U.S. Patent Application Publication No. 2001/0037454 to Botti et al., U.S. Patent Application Publication No. 2005/0039912 to Borrowman et al., U.S. Patent Application Publication No. 2004/0049521 to Borrowman, U.S. Patent Application Publication No. 2004/0255120 to Botti et al., and U.S. Patent Application Publication No. 2006/0010501 to Borrowman.

U.S. Patent Application Publication No. 2003/0051144 to Williams is submitted in an IDS attached hereto. This reference may also be of particular interest to the Examiner.

### **Claim Objections**

The Examiner objected to claims 2-7, 9, and 11-24 as containing various informalities. Applicants have amended the claims to correct these informalities. In particular, Applicants have amended claims 3 and 13 to correct the “if” language objected to be the Examiner, amended claims 9 and 18 to remove the word “used” as suggested by the Examiner, corrected the dependent language of claims 19-24 as suggested by the Examiner, and amended claim 11 to recite a processor “to control” various actions. These amendments to the claims were made to more particularly point out and claim what the Applicants regards as their invention.

Applicants note the suggestion of the Examiner to clarify the language of the claims to specify that the “request” is an electronic request. Applicants do not believe that this amendment is material to the patentability of the claims.

### **Claim Rejections - 35 U.S.C. § 112**

The Examiner rejected claims 9 and 18 under § 112, second paragraph as indefinite because the limitation “the time of submission” lacks antecedent basis. Applicants have corrected this error.

### **Claim Rejections - 35 U.S.C. § 102**

The Examiner rejected claims 2-7, 9, and 11-24 as anticipated by U.S. Patent No. 6,796,489 to Slater et al. This rejection is respectfully traversed.

Slater is directed to a system for processing documents with embedded electronic signatures using signature blocks to embed the digital signatures. Slater fails to teach or suggest all of the elements of independent claim 9. Claim 9 recites “a method of interactive processing of a document...” Many of the elements of the method recited in claim 9 are not taught or suggested by Slater.

The examiner cites col. 9, lines 25-40 of Slater as anticipating the element of claim 9 reciting “providing at least one **request** to a first user at a first location on a computer network for information to complete the document” (emphasis added). But the portion of Slater cited by the Examiner only discusses a signature block “used to contain a digital signature of the signer as well as other information.” The signature block in Slater is merely a space for a user to sign. There is no teaching or suggestion in the cited portion of Slater of any **request** to a first user, much less “at least one request... for information to complete the document.” This element of claim 9 is not present in Slater.

Another element of claim 9 recites “receiving at least one response from the first user to the at least one request for information to complete the document...” Because Slater does not

teach or suggest any request to a user, there cannot be “at least one response from the first user...” in Slater as recited in claim 9. This element is also not taught or suggested by Slater.

Another element in claim 9 recites “writing information obtained from the at least one response from the first user to at least one digital file...” Because Slater does not teach or suggest a response as discussed above, there is nothing in Slater that teaches or suggests that a processor write “information obtained from the at least one response...”

The Examiner cites col. 8, lines 24-50 as anticipating the element of claim 9 reciting “performing a first digital signature routine on the at least one digital file to obtain a first digital signature of the at least one digital file...” The cited portion of Slater states that “an electronic document 200 passes through various states”, such as a “signable state” and a “notarizable state.” But there is no teaching or suggestion in the cited portion of Slater of any “digital signature routine” as recited in claim 9 of the present application. In fact, Slater does not give any explanation as to how a digital signature is created or attached to an electronic file. Thus, Slater does not teach or suggest this element of claim 9 of the present application.

The Examiner cites col. 10, lines 34-50 of Slater as disclosing the element of claim 9 reciting “providing at least one request to a second user at a second location on the computer network for information to complete the document...” The cited portion of Slater discusses reconstructing an electronic document after it has been signed by a first signer and sending a copy of the document to the first signer. There is no teaching or suggestion of any “request” sent to any user in the cited portion of Slater as specifically recited in claim 9 of the present application. The portion of Slater cited by the Examiner merely states that a document may be e-

mailed from a first signer to a second signer. Thus, Slater does not teach or suggest this element of claim 9 of the present application.

Another element of claim 9 recites “receiving at least one response from the second user to the at least one request for information to complete the document.” Because Slater does not teach or suggest any request to any user as discussed above, there can be no “response” to any “request” in Slater, as recited in claim 9. Thus, Slater does not teach or suggest this element of claim 9 of the present application.

Another element of claim 9 recites “writing information obtained from the at least one response from the second user to the at least one digital file...” As discussed above, because Slater does not teach or suggest a “request” there can be no “response” to any “request.” Thus, Slater fails to anticipate this element of the claim.

The Examiner cites col. 10, lines 51-59 of Slater as anticipating the element of claim 9 reciting “performing a second digital signature routine on the at least one digital file to obtain a second digital signature of the at least one digital file...” The cited portion of Slater states that a completed electronic document may have multiple signatures. The cited portion of Slater does not teach or suggest any digital signature routine. In fact, the cited portion of Slater does not describe as to how a digital signature is created. Slater does not teach or suggest a “routine” performed “on the at least one digital file,” as recited in claim 9 of the present application. In fact, while Slater fails to teach or suggest any digital signature routine at all, claim 9 recites a “first digital signature routine” as well as a “second digital signature routine.” Thus, Slater not teach or suggest this element of claim 9 of the present application.

Independent claim 11 recites a system for interactive processing of a document comprising, among other elements, a processor directed by instructions included in a program to execute a number of steps. Many of these elements are not taught or suggested by Slater. One element of claim 11 is “sending of at least one request determined from a selected document to a first user at a first location on a computer network” (emphasis added). The examiner cites col. 9, lines 25-40 of Slater as anticipating this step. But the portion of Slater cited by the Examiner only discusses a signature block “used to contain a digital signature of the signer as well as other information.” The signature block in Slater is merely a space for a user to sign. There is no teaching or suggestion in the cited portion of Slater of any “request...” This element of claim 11 is not present in Slater.

Another element of claim 11 is “receiving of at least one response from the first user to the at least one request...” Because there is no request in Slater, as discussed above, Slater cannot teach or suggest a response to any request, as recited in claim 11.

Another element of claim 11 is “writing of information obtained from the at least one response from the first user onto at least one digital file...” Because there is no response taught or suggested by Slater, as discussed above, Slater cannot teach or suggest “writing of information from the at least one response..”

The Examiner cites col. 8, lines 24-50 of Slater as anticipating the element of claim 11 reciting “determining of a first time stamp from the timing device corresponding to the receipt of the at least one response from the first user to the at least one request from the first user...” As discussed above, Slater does not teach or suggest a “request” or “response.” The cited portion of Slater discusses routing information that may be attached to an electronic document. Nothing in

the cited portion of Slater discusses any time stamp or timing device. In fact, the term “time” does not even appear in the cited portion of Slater. Applicants acknowledge that while col. 13, lines 30-37 of Slater discloses “a timestamp attribute that identifies when the electronic document was digitally signed,” there is no description of any timing device anywhere in Slater. Thus, Slater does not teach or suggest this element of claim 11 of the present application.

The Examiner cites col. 8, lines 24-50 as anticipating the element of claim 11 reciting “performing of a first digital signature routine on the at least one digital file to obtain an original digital signature...” The cited portion of Slater states that “an electronic document 200 passes through various states”, such as a “signable state” and a “notarizable state.” But there is no teaching or suggestion in the cited portion of Slater of any “digital signature routine” as recited in claim 11 of the present application. In fact, Slater does not give any explanation as to how a digital signature is created or attached to an electronic file. Thus, Slater does not teach or suggest this element of claim 11.

The Examiner cites col. 8, lines 24-50 of Slater as anticipating the element of claim 11 reciting “recording of the first time stamp and first original digital signature associated with the at least one digital file in a database...” The cited portion of Slater discusses routing information which may be attached to an electronic document. The cited portion of Slater does not teach or suggest any database. The only database disclosed in Slater is discussed in col. 15, lines 17-31, which stores electronic documents, not a “first time stamp and first original digital signature” as recited in claim 11 of the present application. Thus, Slater not teach or suggest this element of claim 11 of the present application.

The Examiner cites col. 10, lines 34-50 of Slater as anticipating the element of claim 11 reciting “sending of at least one request determined from the selected document to a second user at a second location on a computer network...” The cited portion of Slater discusses reconstructing an electronic document after it has been signed by a first signer and sending a copy of the document to the first signer. There is no teaching or suggestion of any “request” sent to “a second user at a second location” as recited in claim 11 of the present application. The portion of Slater signed by the Examiner merely states that a document may be e-mailed from a first signer to a second signer. Thus, Slater not teach or suggest this element of claim 11 of the present application.

The Examiner cites col. 3, lines 13-16 as anticipating the element of claim 11 which recites “receiving of at least one response from the second user to the at least one request from the second user...” The cited portion of Slater discloses sending an electronic document and a receipt for the electronic document back to the individual that signed the document. As discussed above, there is no request taught or suggested by Slater. There is no teaching or suggestion in the cited portion of Slater of a “at least one response from the second user” as recited in claim 11. Thus, Slater not teach or suggest this element of claim 11 of the present application.

The Examiner again cites col. 3, lines 13-16 as anticipating the element of claim 11 reciting “writing of information obtained from the at least one response from the second user to at least one digital file...” The cited portion of Slater merely discusses a receipt provided to a user, it does not teach or suggest writing information obtained from a response from a second



user to a digital file as recited in claim 11 of the present application. Thus, Slater not teach or suggest this element of claim 11 of the present application.

Independent claim 18 is directed to a computer readable program code executable on a computer, including computer readable program code to execute many of the same elements enumerated discussed above in connection with claims 9 and 11. Thus, independent claim 18 is not anticipated by Slater for at least the same reasons discussed above in connection with claims 9 and 11.

The Examiner cites col. 3, lines 13-16 of Slater as anticipating the additional elements in dependent claims 3, 13, and 20. The cited portion of Slater states that a document and a receipt are returned to the originator of the document. The Examiner states that this portion of Slater anticipates the element “sending at least one additional request to the first user for additional information when the at least one response from the first user is invalid” as recited in claims 3, 13, and 20. As discussed above in connection with claims 9 and 11, the cited portion of Slater does not teach or suggest sending any “request” to a user. The cited portion merely sends a receipt and a signed document back to an originator. No request is sent to the originator. Thus, this element is not present in the cited portion of Slater.

The Examiner cites col. 16, lines 25-59 of Slater as anticipating the additional elements in dependent claims 4, 14, and 21. The cited portion of Slater states that “routing information permits error documents and receipts... to be associated with the appropriate order or electronic document. Recorded documents can be returned to the sending server or user.” Thus, documents may be returned to a server from which they were sent. The additional limitation in claims 4, 14, and 21 states that “an additional request” is sent to a second user for additional

information “when the at least one response from the second user is invalid.” As discussed above in connection with claim 9 and 11, Slater does not teach or suggest any request sent to any user. The cited portion merely states that Slater may return a document to an originating “sending server or user.” There is no request for information or additional request for information taught or suggested in Slater as recited in claims 4, 14, and 21. Thus, Slater does not anticipate claims 4, 14, or 21.

The Examiner cites col. 10, line 34-50 as anticipating the additional elements in claims 5, 15, and 22. The cited portion of Slater discusses a signer emailing a document to a second signer and copies of the signed documents being emailed to all signers after each signer has signed. The additional element in claims 5, 15, and 22 states that feedback is provided to the first user, “the feedback determined in part by the at least one response to the at least one request received from the first user.” As discussed above in connection with independent claims 9 and 11, there is no request taught or suggested in Slater and thus there can be no response to any request. Thus, Slater does not anticipate claims 5, 15, and 22.

The Examiner cites col. 16, lines 25-59 as anticipating the additional elements in claims 6-7, 16-17, and 23-24. The additional elements in these claims comprise providing feedback to a second user determined in part by the at least one response to the at least one request received from the second user. Because the cited portion of Slater does not teach or suggest any request, Slater also does not teach or suggest any feedback based on any request or response to a request. The cited portion of Slater fails to anticipate this additional limitation. Thus, Slater fails to anticipate claims 6-7, 16-17, and 23-24.

Applicants respectfully submit that the remaining dependent claims pending in the present application are also patentable as submitted as patentable at least by virtue of their ultimate dependence on the patentable independent claims discussed above. Although Applicants have not separately argued the patentability of each of the dependent claims, Applicants' failure to do so is not to be taken as an admission that the features of the dependent claims are not themselves patentable over the prior art cited by the Examiner.

### **Conclusion**

As it is believed that all of the rejections set forth in the Office Action have been fully met, favorable reconsideration and allowance are respectfully requested.

Respectfully submitted,

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